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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,933	07/29/2003	Anandan Palani	IN01481KC	7512

24265 7590 10/27/2005

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/628,933	Applicant(s) PALANI ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of group I, the species of compound 56 on page 61 in the reply filed on Aug. 17, 2005 is acknowledged. The traversal is on the grounds that the examiner has not established a clear reason that i) separate classification, ii) separate status in the art or iii) different field of search, to justify restriction. This is not found persuasive because please note that the class and when possible, the subclasses of each group was clearly delineated in the office action. A very detailed explanation with respect to the required species election in the compound groups has also been delineated on page 4. Applicants were advised but provided no evidence that all the inventions are *obvious* variations being recognized by the state of the art. Please note that MPEP § 803.02 specifically defines that propriety of Markush grouping must evidence common utility and substantial structural feature disclosed as being essential to that utility. The substantial common structural feature must be and art recognized core. In re Harnish 205 USPQ 300. Applicants provided no evidence mere allegation that "the same art search will most probably apply to the alleged separate inventions". Please note that clear delineation of class and subclass in the previous office action *evidenced* such an allegation is erroneous. Should applicant insist upon that all the inventions are not patentably distinct, then there could have been no patentability of all the claims over US 2004/0142920 (102(e) reference), see example 69 on page 12 which anticipated compounds other group I i.e. not both R¹ and R² are nonheterocyclic; or see example 9 on page 5 when the election is not limited to the species wherein R⁴ is C₁₋₆Alkyl-NR²¹SO₂R²², i.e. R¹ is optionally unsubstituted aryl.

The requirement is still deemed proper and is therefore made FINAL. Based on the election, group I being drawn to claim 24, and the scope of claims 21-23, 25-30 wherein R¹ is MR⁴, wherein M is phenyl, R⁴ is C₁₋₆Alkyl-NR²¹SO₂R²², R² is non-heterocyclic, R³ is substituted or unsubstituted pyrimidine, are examined. Claims 31-40 and the remaining subject matter of claims 21-23, 25-30 are withdrawn from consideration per 37 CFR 1.142(b).

2. Claims 24 and the scope claims 21-23, 25-30 reading on R¹ is MR⁴, wherein M is phenyl, R⁴ is C₁₋₆Alkyl-NR²¹SO₂R²², R² is non-heterocyclic, R³ is substituted or unsubstituted pyrimidine are provisionally rejected under the judicially created doctrine of obviousness-type

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double patenting as being unpatentable over the pending claims of copending Application No. 10/979,075, see especially corresponding species of claim 17, 1st and 6th compound on page 70, in view of Rubini et al.

Determination of the scope and content of the prior art (MPEP §2141.01)

The copending claims are drawn to analogous compounds of the instantly "elected" scope of R⁴ is C₁₋₆Alkyl-NR²¹SO₂R²².

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant elected scope and the copending species is that instead of R⁴ is C₁₋₆Alkyl-NR²¹SO₂R²², the copending claims are drawn to compounds wherein an ethylene chain of the C₁₋₆Alkyl linker of the R⁴ is replaced by an amide bond. The ethylene linker and an amide bond are considered amide bond surrogate units (see Rubini et al. whole article, especially page 6039, 9th line from bottom).

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art in possession of the copending claims would be motivated to replace the amide bond of the linkage with an amide bond surrogate i.e. an ethylene chain which would be the instant claims. The modification of two sets of compounds with conventional skill in biological active compounds with amide bond surrogate is prima facie obvious because one would expect such modification to produce more compounds with analogous activity.

This is a provisional obviousness-type double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

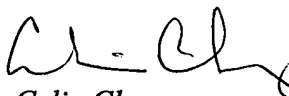
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Oct. 24, 2005



Celia Chang
Primary Examiner
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